



**UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/024,885 02/17/98 ROTH

D T1680CIP2

020451  
GRANT R CLAYTON  
CLAYTON HOWARTH & CANNON, PC  
P O BOX 1909  
SANDY UT 84091-1909

MM91/0122

EXAMINER

ABRAMS, N

ART UNIT

PAPER NUMBER

2839

DATE MAILED:

01/22/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/024885

Applicant(s)

Examiner

Abrams

Group Art Unit

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on 9-20-00 (RCE)  
9-7-00 Amendment
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 34-39, 68-71 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☒ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 34-39, 68-71 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

Office Action Summary

Should be 17

Part of Paper No. 15

Art Unit: 2839

The request for continued examination (RCE) is acknowledged.

Applicant is asked to list claims pending in this case.

In rejections below, the Kakinoki patent "prior art" fig. 5 disclosure is applied. It appears that this figure should be viewed as depicting conventional structure, known prior to the date of the Japan priority document, Nov. 20, 1992 or at least prior to the U.S. filing date. Applicants are asked to comment on the above position and whether or not ~~the~~<sup>they</sup> accept the fig. 5 disclosure as prior art.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 34-39 and 68-71 are rejected under the judicially created doctrine of double patenting over claims 1-19 of U. S. Patent No. 5,411,405 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: The claims of this case define broadened variations of the parent case claims

Art Unit: 2839

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

A terminal disclaimer could be submitted with the next response to expedite the case.

The omission of claims 34-39 from prior double patenting rejections appears to have been an oversight.

Claims 34-39 and 68-71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kakinoki in view of Clarke, Hardesty and Research Disclosure.

See Kakinoki, fig. 5. It would have been obvious to replace part 50 with a removably joined adapter like those of the secondary references.

Claims 34-39 and 68-71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aldous 404 in view of Clark, Hardesty and Research Disclosure.

It would have been obvious to combine the Aldous cards of 3, 5, 7, 8, 9, 15 with a removably attached adapter in view of the secondary references.

In particular, see Aldous, fig. 7, with cabled adapter (DAA) 48. An adapter like those of any one of the secondary references would be equivalent to such cabled adapter.

Applicant's arguments filed with the amendment have been fully considered but they are not persuasive. See discussions above of the applied references. Terms "compliant with.... III card" do not define over cards like 40 of Aldous, figs. 3-9.

Application/Control Number: 09/024,885


Page 4

Art Unit: 2839

Any inquiry concerning this communication should be directed to N. Abrams at telephone number (703) 308-1729.

Abrams/nt

1-4-01

  
NEIL ABRAMS  
EXAMINER  
ART UNIT 322